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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHANG, JUNGWON

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/937,347

Applicant(s)

BAUER ET AL.

Examiner

Jungwon Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/12/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is responsive to preliminary amendment filed on 9/24/2001. Claims 1-14 are amended, new claims 15-24 are added. Claims 1-24 are presented for examination.
2. The information disclosure statement filed on 10/12/2001 has been considered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - a. The claim language in the following claims is not clearly understood:
 - i. As to claim 1, lines 8-9, it is unclear what is meant by "transmitting from the first computer only the user elements of the service, such that user elements travel between the second computer and the user computer" (i.e., firstly, the first computer centrally manages the interface elements and the second computer defines the user elements as recited in preamble of claim 1. Since the first computer manages the interface elements, how the first computer can transmit only the user elements of the service?; secondly, according to substitute specification on page 3, paragraph 0021,

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states that "first computer is then set up in such a manner that the first computer transmits the user elements between the second computer and the user computer. During operation of the service, only the user elements are transmitted between the second computer and the user computer". That does not mean that "first computer transmits only the user elements of the service).

- ii. Claims 2, 8 and 9 have the same deficiency as claim 1 above.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, 4, 5, 8, 9, 11, 12, 16, 17, 20, 21, 23 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Nieminen et al. (US 6,578,075), hereinafter Nieminen.

7. As to claim 1, Nieminen discloses the invention as claimed, including a method for installation of a service (distributing various services; col. 1, lines 9-13; col. 2, lines

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30-33), which comprises interface elements (provision of tailored user interfaces; col. 2, lines 30-33, 44-46; col. 3, lines 1-6, 45-51) and user elements (identify the type of terminal means; col. 3, lines 52-67; terminal means profile; col. 4, lines 4-15), on a user computer (col. 5, lines 5-11) from a computer structure which has a first computer (2, 4, fig. 1), which centrally manages the interface elements (provision of tailored user interfaces; col. 2, lines 30-33, 44-46; col. 3, lines 1-6, 45-51), and a second computer (service provider, 6, fig. 1), which defines the user elements (each user is provided with a personal service according to the facilities he/she may have and/or preferences he/she may have defined; col. 4, lines 16-42), comprising:

connecting the user computer and the computer structure (figs. 1, 2; col. 4, line 67 – col. 5, line 14);

transmitting interface elements to the user computer from the first computer after the user computer requests the service (user initiates service use, fig. 3) (ISB delivers service program, fig. 3; col. 5, lines 36-47; col. 6, lines 37-51; col. 8, line 61 – col. 9, line 3); and

after transmitting interface elements to the user computer, transmitting from the first computer only the user elements of the service, such that user elements travel between the second computer and the user computer (during the use of the actual service may be arranged to occur directly between the user terminal and the service, while the ISB only monitors the connection; col. 10, lines 19-34; connections between the service providers and the users; col. 4, lines 16-42).

8. As to claim 2, it is rejected for the same reasons set forth in claim 1 above. In addition, Nieminen discloses during operation of the service, transmitting from the first computer only the user elements of the service, such that user elements travel between the second computer and the user computer (during the use of the actual service may be arranged to occur directly between the user terminal and the service, while the ISB only monitors the connection; col. 10, lines 19-34; connections between the service providers and the users; col. 4, lines 16-42).

9. As to claim 4, Nieminen discloses wherein the first computer (2, 4, fig. 1) is connected both to the user computer (1, fig. 1) and to the second computer (6, fig. 1).

10. As to claim 5, Nieminen discloses wherein the user computer is a mobile telephone (cellular phone users; col. 6, lines 45-51).

11. As to claims 8 and 9, they are rejected for the same reasons set forth in claims 1 and 2 above. In addition, Nieminen discloses a request unit at the user computer to request the service (user initiates service use; fig. 3; request for an access to a service; fig. 4; client terminal means for requesting; col. 4, lines 1-3); an interface transmission unit at the first computer to transmit the interface elements to the user (ISB delivers service program, fig. 3; col. 5, lines 36-47; col. 6, lines 37-51; col. 8, line 61 – col. 9, line 3); a user element transmission unit to transmit during operation of the service (identify the type of terminal means; col. 3, lines 52-67; terminal means profile; col. 4, lines 4-15;

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data transfer path between the service provider and the connection manager; col. 8, lines 15-27).

12. As to claims 11, 16 and 20, they are rejected for the same reasons set forth in claim 4 above.

13. As to claims 12, 17 and 21, they are rejected for the same reasons set forth in claim 5 above.

14. As to claims 23 and 24, Nieminen discloses the interface elements are transmitted to the user computer after the request unit requests the service (user initiates service use, fig. 3; request for an access to a service; fig. 4; client terminal means for requesting; col. 4, lines 1-3) (ISB delivers service program, fig. 3; col. 5, lines 36-47; col. 6, lines 37-51; col. 8, line 61 – col. 9, line 3).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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16. Claims 3, 10, 15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nieminen et al. (US 6,578,075), in view of Wong et al. (US 6,260,021), hereinafter Wong.

17. As to claim 3, Nieminen discloses installing interface elements (various programs have to be separately provided and installed into the used data processing device prior to using the service; col. 2, lines 30-33; provision of tailored user interfaces; col. 2, lines 30-33, 44-46; col. 3, lines 1-6, 45-51). Nieminen also discloses graphical user interface (col. 6, lines 45-51; col. 1, lines 37-46). The graphical user interface inherently contains program code executable by the processor for prompting the user to interface with the computer via its display system. However, Nieminen does not specifically disclose graphical user interface objects are transmitted as the interface elements. Wong discloses graphical user interface objects are transmitted as the interface elements (downloading new Java-coded GUI objects for their display; col. 8, line 53 – col. 9, line 29). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Nieminen and Wong because Wong's downloading GUI objects would improve bandwidth by allowing the thin client like a mobile device, which has relatively small memory capacity to dynamically downloading the GUI objects when needed.

18. As to claims 10, 15 and 19, they are rejected for the same reasons set forth in claim 3 above.

19. Claims 6, 7, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nieminen et al. (US 6,578,075), in view of Richton (US 6,199,010).

20. As to claim 6, Nieminen discloses the user elements (identify the type of terminal means; col. 3, lines 52-67; terminal means profile; col. 4, lines 4-15). However, Nieminen does not specifically the user elements relate to traffic information. Richton discloses traffic information (col. 2, line 53 – col. 3, line 18; col. 6, lines 24-44). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Nieminen and Richton because Richton's traffic information would efficiently assist the traveler to keep tracking his movement during the trip.

21. As to claim 7, Nieminen does not specifically disclose the first computer is a personal travel assistant. Richton discloses personal travel assistant (221, figs. 2, 3, 5; col. 2, line 43 – col. 3, line 18; col. 4, lines 19-51; col. 5, lines 12-60; col. 6, lines 24-44; col. 9, lines 3-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Nieminen and Richton because Richton's personal travel assistant would efficiently assist the traveler to keep tracking his movement during the trip.

22. As to claim 13, it is rejected for the same reasons set forth in claim 6 above.

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23. As to claim 14, it is rejected for the same reasons set forth in claim 7 above.

24. Claims 18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nieminen et al. (US 6,578,075), Wong et al. (US 6,260,021), further in view of Richton (US 6,199,010).

25. As to claims 18 and 22, Nieminen discloses the user elements (identify the type of terminal means; col. 3, lines 52-67; terminal means profile; col. 4, lines 4-15). However, Nieminen and Wong do not specifically the user elements relate to traffic information. Richton discloses traffic information (col. 2, line 53 – col. 3, line 18; col. 6, lines 24-44). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Nieminen, Wong and Richton because Richton's traffic information would efficiently assist the traveler to keep tracking his movement during the trip.

Conclusion

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:


Munguia et al, 2001/0052013, Kennedy, III et al, patent 6,535,743, Tognazzini, patent 5,790,974 disclose a method and system for providing a variety of enhanced services to the mobile units.

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27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jungwon Chang whose telephone number is 571-272-3960. The examiner can normally be reached on 9:30-6:00 (Monday-Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jungwon Chang
September 9, 2005